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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/293,266	04/16/1999	RAYMOND WALDEN BENNETT III	A00513	4651
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BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610			EXAMINER AGDEPPA, HECTOR A	
			ART UNIT 2642	PAPER NUMBER

DATE MAILED: 01/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/293,266

Applicant(s)

BENNETT III ET AL.

Examiner

Hector A. Agdeppa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 1 – 4, 6, 8 – 11, 13 – 17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,903,632 (Brandon), US 5,745,553 (Mirville et al.), and further in view of US 6,160,877 (Tatchell et al.)

As to claims 1 – 4, 6, 8 – 11, 13 – 17, and 19, Brandon teaches an automated telephone directory for creating outgoing call logs wherefrom called numbers and/or the names associated with the called numbers may be displayed display 3 of telephone 1, retrieved, and dialed by a single input made by depressing call key 82. (Abstract, Figs. 1, 4 – 7, Col. 2, lines 32 – 67, Col. 3, line 54 – Col. 4, line 34, and Col. 5, line 7 – Col. 6, line 64 of Brandon)

However, it is old and well known that service residing in/on a telephone unit may be provided at a central office (C.O.) or switch, the functionality no longer residing with the telephone, but within the C.O. or switch requiring a caller to dial a service code to invoke a feature and presenting any information via audio messaging. Examples of this are voice mail (as opposed to an answering machine) and remote access speed dialing (as opposed to local speed dialing, i.e., database kept in switch as opposed to being kept in telephone unit) such as the system for on-demand communications services.

An example of such a speed dialing on-demand service is taught by Mirville et al. wherein a caller uses telephone or end unit 101, 103, 105 to dial a service code such as #1 to access the speed dial feature, and wherein the list of speed dial numbers resides in a storage device 190 separate from units 101, 103, or 105. (Figs. 1, 3, 4, Col. 6, lines 28 – 54 of Mirville et al.) Note also that Mirville et al teaches that any telephony feature may be implemented in such an on-demand/network-based manner. (Col. 1, lines 11 – 22, Col. 2, lines 43 – 59, Col. 4, lines 33 – 62 of Mirville et al.)

It would have been obvious to one skilled in the art to implement the invention of Brandon in the manner taught by Mirville et al., i.e. functionality residing away from the telephone, making it thus necessary to dial a service code and receive relevant information via audio messaging inasmuch as it is old and well known to implement telephony features in either environment. Furthermore, keeping an outgoing call log in a C.O. or switch allows for more memory and therefore a more extensive outgoing call log may be kept. Also, situations may arise when outgoing call logs are kept only on a telephone unit, wherein if a caller has multiple telephones, that caller must use the

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same telephone previously used in order to redial a previously called number, because there is no way for that previously dialed number to be transferred to another telephone.

Also, because, often, listening to audio messages, in particular, those reciting lists are difficult to remember and use information contained therein, visually displaying lists is favored. However, many telephones commonly used today still do not display information and thus, lists would have to be presented via audio messaging.

Furthermore, such is simply an issue of preference or design choice as to whether an outgoing call list is to be presented visually or via audio messaging. Also, to that point, a blind caller would have to have information normally visually displayed, converted to audio or Braille, in either case, requiring converting data into a preferred format and such conversions are old and well known in the art, again making the modification of Brandon's invention from a visual apparatus to an audio apparatus obvious to one skilled in the art.

An example of announcing call logs/call log information to a user as opposed to visually displaying such information is taught by Tatchell et al. Tatchell et al. teaches a personal agent residing on the telephone network such as at telephone switching center 10, the personal agent accessible by a user from any telephone, anywhere, (as opposed to only locally/resident on a particular telephone) for managing calls. (Col. 65, line 61 – Col. 7, line 32 of Tatchell et al.) Tatchell et al. further teaches announcing, via text to speech technology, an incoming call list, after which a user may interrupt the announcement and dial one of the numbers or names presented by the announcement. (Col. 16, line 48 – Col. 17, line 58 of Tatchell et al.) Tatchell et al. teaches using a voice

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command but again, as is well known, voice command dialing is merely a well known advance over dialed inputs. Moreover, voice commands are in reality just translated into dialed or DTMF tones, or at the least, functionally equivalent in terms of effecting the same result.

It would have been obvious for one of ordinary skill in the art at the time the invention was made to have combined Brandon, Mirville et al., and Tatchell et al. inasmuch as Tatchell et al. as discussed merely teaches a concrete example of the preference to have audio announcement as opposed to visual display of information. Moreover, Tatchell et al. teaches a telephony network-based system as Mirville et al. and teaches accessing and dialing from a call log as Brandon.

2. Claims 5, 7, 12, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,903,632 (Brandon), US 5,745,553 (Mirville et al.), US 6,160,877 (Tatchell et al.), and further in view of US 6,076,121 (Levine).

As to claims 5, 12, and 18, Brandon, Mirville et al., and Tatchell et al. have been discussed above. What they do not teach is the use of a vertical service code.

However, any type of service code used to access a service or feature is a question of preference or design choice making the use of a vertical service code obvious to one skilled in the art. Furthermore, as taught by Levine, vertical service codes are old and well known in the art and it would again be obvious to access redial features of the claimed invention using such. (Col. 12, lines 1 – 46 of Levine)

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As to claim 7, Brandon teaches displaying outgoing call lists one page at a time. If this were translated into audio, it is obvious if not inherent that call lists would be presented in blocks likened to pages, perhaps 4 numbers at a time to make it easier for a user to utilize redial feature or at least present numbers one at a time, requiring a user to somehow prompt a next number to be presented. Therefore, the page scrolling taught by Brandon would be translated into the first and second audio messages and multiple dial inputs of the claimed invention. Also, as discussed above, as in the case of voice mail or many other services provided remotely to a user, a PIN would be necessary and thus it is obvious if not inherent to require the inputting of a PIN as claimed by the instant invention.

Response to Arguments

3. Applicant's arguments with respect to claims 1 - 19 have been considered but are moot in view of the new ground(s) of rejection.

However, for further clarification, examiner directs applicant to the response to arguments filed in the previous office action. Examiner clearly explained there and in the above rejection that the speed dial feature of Mirville et al. is an example of a feature that can be implemented on both a local/telephone-resident scale as well as on a telephony network scale. Therefore, simply because Brandon teaches a local/telephone-resident outbound call log does not mean that it could not be implemented on the telephony network. In fact, examiner has cited various reasons and motivation for doing so.

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As to applicant's arguments regarding accessing of records, examiner is arguing that if the functionality of Brandon, i.e., outbound call log dialing were to be implemented on a telephony network, records would be stored on the network and not on any particular telephone, just as in Mirville et al. that teaches instead of a speed dialing database being kept on a particular telephone, the database would be kept on the network.

Again, as discussed above, and previously, examiner asks applicant to consider traditional answering machines. In traditional answering machines, voice messages were kept on tape or digitally on the actual machine that was co-located with a particular telephone. However, with the advent of voicemail, voice messages could be kept in a database on the telephone network or at a telephony network switch or central office, etc. but could still be accessed by a user by dialing into the network or voice mail system. The same reasoning is obviously applicable to outbound call log dialing.

Moreover, as already mentioned above, Mirville et al. contemplates the ability to present users with any feature in an on-demand manner, not just speed-dialing, again reinforcing examiner's position that the feature taught by Brandon could obviously be combined or modified to work in the manner taught by Mirville et al.

As to applicant's remaining arguments relating to claim 7, examiner provided clear reasoning as why such features would be inherent or obvious. See also Tatchell et al., Col. 7, lines 5 – 9 wherein it is taught that a user would access the personal agent via an 800 number. Again, the only way a user could be identified is if that user entered some sort of PIN or identifying indicia. Also, as is well known, if such security and

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authority measures were not taken, anyone could access and utilize anyone else's records, preferences, etc. and of course that is undesirable. Again, look to accessing one's voice mail wherein one must identify him/herself using a PIN and/or his/her account/telephone number.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 5,535,258 (Joglekar et al.) teaches a system and method of audibly presenting a list of most frequently dialed numbers that a user may "scroll" though and choose to dial. US 6,212,408 (Son et al.) teaches a voice command system and method wherein vocal commands are converted into the appropriate and associated DTMF tones.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hector A. Agdeppa whose telephone number is 703-305-1844. The examiner can normally be reached on Mon thru Fri 9:30am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad F. Matar can be reached on 703-305-4731. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

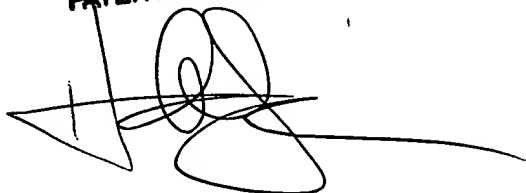
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

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H.A.A.
January 14, 2005

HECTOR A. AGDEPPA
PATENT EXAMINER

A handwritten signature in black ink, consisting of a series of loops and a long horizontal stroke extending to the right.